

REMARKS

Claims 1 – 6 and 8 – 13 are currently pending in the application.

It is respectfully submitted that the Examiner's reasoning in rejecting claim 1 as being obvious in view of Montgomery ('908) or Bockhorst et al when taken with Grossman and Close et al or Arriens is erroneous.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The prior art must suggest the desirability of the claimed invention. Neither the prior art of record or the general knowledge of the skilled person provides any such teaching, suggestion or motivation. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. The mere fact that the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.

Montgomery and Bockhorst disclose methods and apparatus which purport to be capable of acoustically transmitting signals over arbitrarily long lengths of drill string. The natural use for such methods and apparatus would be to transmit data from a downhole location directly to the surface. Such transmission would bypass an obstruction in the internal bore of the drill string, and would not require the acoustic signal to be converted into an electric signal at a location closely adjacent the surface side of the obstruction and stored for subsequent retrieval, as required by the present claim 1. That is, taking the teaching of Montgomery or Bockhorst as a starting point, the skilled person would have no motivation, in the light of the prior art of record, to modify the methods or apparatus as taught by these references in order to arrive at the invention as defined in the present claim 1. If the methods and apparatus as taught by

Montgomery or Bockhorst were capable of practical implementation in the manner taught therein, then they would provide a complete solution to the problem addressed by the present invention. Accordingly, there would be no reason for the skilled person to modify such methods and apparatus in the manner required by the present claim 1.

If the skilled person was aware that the teachings of Montgomery and Bockhorst were not capable of practical implementation, none of the teachings or suggestions provided by the prior art references of record and/or the general knowledge of the skilled person would lead the skilled person to modify the methods and apparatus of Montgomery or Bockhorst in the light of Grossman and Close et al or Arriens in such a way as to arrive at the invention of the present claim 1.

For these reasons, it is submitted that the subject matter of the present claim 1 cannot be said to be obvious in the light of the prior art of record.

It is, therefore, respectfully requested that the rejections be reconsidered and withdrawn. A notice of allowance is solicited.

Respectfully submitted,

DAVID B. SMITH

BY:


GREGORY J. LAVORGNA
Registration No. 30,469
Drinker Biddle & Reath LLP
One Logan Square
18th & Cherry Streets
Philadelphia, PA 19103-6996
Tel. 215-988-3309
Fax 215-988-2757

Attorney for Applicant